

### **REMARKS/ARGUMENTS**

Prior to entry of this amendment, the application included claims 1-38. An Office Action mailed February 9, 2006, rejected claims 1-11, 13-18, 20, 21, 23-29 and 31-38 under 35 U.S.C. § 102(e) as being anticipated by US Patent No. 6,499,026 to Rivette et al. ("Rivette"). Claims 12, 19, 22 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rivette.

This amendment neither amends, adds nor cancels any claims. Hence, after entry of this amendment, claims 1-38 will remain pending for examination.

#### **Formal Matters**

The applicants thank the Examiner for initialing the information disclosure sheet filed April 13, 2003. The applications note for the record that they also filed an information disclosure statement on June 23, 2006. To date, the applicants have not received any indication that the references cited on the information disclosure statement have been considered by the Office. The applications respectfully request the return of the PTO form SB/08 sheets included with the information disclosure statement, initialed by the Examiner to indicate the Office's consideration of the cited references.

#### **§ 102 Rejections**

Claims 1-11, 13-18, 20, 21, 23-29 and 31-38 stand rejected under § 102(e) as being anticipated by Rivette. The applicants respectfully traverse these rejections and submit the following arguments in support of their position.

Rivette fails to teach or suggest any element of any pending claim, and all claims therefore are believed to be allowable over Rivette. Claims 1, 13, 20, 32 and 35 are independent claims, and Rivette fails to teach or suggest each element of any of those claims. In particular, it is worth noting that the present claims and Rivette, respectively, are directed to solutions to two very different problems. The present claims are directed to solutions for providing information about a single patent application at a time. As such, they recite systems, methods and interfaces

that allow a patent prosecutor, inventor, patent owner, etc. to easily deal with images of documents (such as correspondence from an inventor, outside counsel, a patent office, etc.), as well as files generated by an application (such as a patent application, a response to an office action, etc.). Accordingly, the user interfaces recited by the present claims are designed to allow the user to view and work with relevant documents and files from a single patent application in an organized manner.

In contrast, Rivette is directed to an intellectual property analysis system that allows for the grouping of large numbers of issued patents for analysis, in order to inform business decisions based on those patents. *See, e.g., Rivette, c. 11, ll. 46-52.* Accordingly, the user interface of Rivette is designed to allow a user to view multiple patents (and other, non-patent documents) on a group basis, basically allowing a user to survey the patent landscape in a particular technology area.

Because Rivette is directed to solving a very different problem than that addressed by the present claims, it is perhaps unsurprising that Rivette does not teach or suggest the elements of any of the pending claims.

#### Claims 1-11 and 37

Take claim 1, for example. Claim 1 recites, inter alia, “a first display section in which is displayed a plurality of first file links selectable by said user, each of said first file links providing access to a patent document that was filed in or sent from a patent office and that is stored on a computer-readable medium in an image file format, wherein when one of said first file links is selected an associated underlying resource is automatically returned.” Claim 1 also recites “a second display section in which is displayed a plurality of second file links selectable by said user, each of said second file links providing access to a patent file that is associated with an application program and stored on a computer-readable medium.” Finally, claim 1 recites that “said patent documents and said patent files accessible from said first and second display sections all pertain to said patent application.”

Rivette teaches none of these elements. The office action cites column 117 and Fig. 114 of Rivette as teaching both the first display section and the second display section recited by claim 1. The cited portion of Rivette, however, teaches neither of these elements. First, with respect to the first display section, claim 1 recites that, in the first display section there are “displayed a plurality of first file links selectable by said user, each of said first file links providing access to a patent document that was filed in or sent from a patent office and that is stored on a computer-readable medium in an image file format.” In contrast, the first display section in Rivette is referred to as a “group pane 11704,” and it contains “a repository group 11710,” which appears to refer to a group of patents or other documents. See Rivette, c. 114, ll. 13-21. This is more clearly illustrated by, *inter alia*, Fig. 118 of Rivette, which shows the multiple panes of Rivette’s interface populated with information.

Clearly, the group pane of Rivette does not display a plurality of file links, each of what provides access to a patent document that is stored on a computer-readable medium in an image file format. Instead, the group pane of Rivette displays groups of documents, which, when selected, display in the second pane (which Rivette refers to as the “document pane,” see *id.*, c. 114, l. 10) a list of documents in the second group. Clearly, when an entry in Rivette’s group pane is selected, it does not provide access to a particular document stored in image file format, as recited by claim 1, but instead provides a list of documents in the second pane. This is a fundamental difference between the interface recited by claim 1 and that disclosed by Rivette, and this difference alone renders claim 1 patentably distinct from Rivette.

Moreover, Rivette fails to teach or suggest that its second pane (the document pane) displays “a plurality of second file links selectable by said user, each of said second file links providing access to a patent file that is associated with an application program and stored on a computer-readable medium.” For one thing, Fig. 117, which the office action relies on, shows nothing at all displayed in the second pane. Rivette does disclose, however, that “[t]he patents and documents [in the document pane] are listed in a tabular or ‘spreadsheet’ format. The list of documents in the document pane 11706 includes both the patent numbers and patent bibliographical information for the patents, and bibliographic information for the non-patent

documents.” *Id.*, c. 114, ll. 25-30. Rivette also discloses that “the operator can view the text and/or image of any patent or other document listed in the document pane 11706 by selecting the patent or document using well-known selection techniques,” which can include double-clicking on a patent number. *Id.*, c. 115, ll. 1-6. Even assuming that these double-clickable patent numbers might be considered file links, however, Rivette contains no teaching or suggestion that those file links might provide access to a patent file that is associated with an application program, rather than the mere text or image of a patent. (In this way, in fact, the document pane of Rivette is more similar to the first display section recited by claim 1 than it is to the second display section, which is how it is construed by the office action.) This is yet another patentable distinction between claim 1 and Rivette’s disclosure.

Finally, Rivette fails to teach or suggest (and in fact appears to teach away from) the last element of claim 1, that “said patent documents and said patent files accessible from said first and second display sections all pertain to said patent application.” Rather than displaying only documents and files related to a single patent application, the user interface disclosed by Fig. 117 and column 114 of Rivette is designed to group multiple patents (and non-patent documents), for example, by subject matter. Hence, when a group of patents is selected in the group pane 11704, multiple patents are displayed in the document pane 11706. This can be clearly seen by Fig. 118. In fact, if Rivette’s interface were modified to display documents from only one patent, there would be little purpose in even having separate group and document panes, since Rivette’s interface seems to be designed to display patents in similar subject matter areas for collective analysis. *See, e.g., id.*, c. 12, l. 53 – c. 13, l. 39 (“Being able to automatically process information on a group basis is a very important feature of the invention, and proves to be very valuable and useful.”)

Accordingly, Rivette fails to teach or suggest any element of claim 1, and that claim therefore is believed to be allowable over Rivette. Dependent claims 2-11 and 37 are believed to be allowable at least by virtue of their dependence from claim 1.

Claims 13-18

Nor does Rivette teach each element of claim 13. Merely by way of example, claim 13 recites storing information that includes “at least (i) correspondence generated from one or more of an inventor client system, an in-house client system and an outside representative client system; (ii) patent documents filed in or sent from a patent office; and (iii) patent files associated with said patent application.” As noted above, Rivette is designed to deal with issued patents, and Rivette accordingly fails to teach or suggest the storage of the types of information recited by claim 13. In particular, nothing in the cited portions of Rivette teaches the storage of “correspondence generated from one or more of an inventor client system, an in-house client system and an outside representative client system.” The applicants respectfully disagree that the ability of a user of the Rivette system to add notes relating to a particular patent or group of patents (c. 114, ll. 114, ll. 47-57, c. 20, ll. 15-20, Figs. 117-118, as cited by the office action) teaches or suggest correspondence generated from the client systems recited in claim 1. In fact, Rivette fails even to teach or suggest such client systems themselves. Nor, as noted above do the document and group panes of Rivette teach the storage of “patent files associated with [a] patent application.”

Further, claim 13 recites “generat[ing] on a display at least first, second and third separate sections wherein said first section comprises file links to said correspondence, said second section comprises file links to said patent documents and said third section comprises file links to said patent files.” As noted above with respect to claim 1, the group pane and document pane of Rivette fail to teach the recited display sections.

For at least these reasons, claim 13 is believed to be allowable over Rivette. Claims 14-18 are believed to be allowable at least by virtue of their dependence, either direct or indirect, from claim 13.

Claims 20, 21, 23-29 and 31

Claim 20 recites, inter alia, storing information including “at least (i) correspondence generated from one or more of an inventor client system, an in-house client system and an outside representative client system; (ii) patent documents filed in or sent from a patent office; and (iii) patent files associated with said patent application, wherein at least some of said patent documents are stored in an image file format and at least some of said patent files are associated with an application program.” As noted with respect to claim 13, Rivette fails to teach or suggest this element. Nor, for substantially the reasons discussed above, does Rivette teach or suggest “generating a web page from said server system, said web page including at least first, second and third separate sections wherein said first section comprises file links to said correspondence, said second section comprises file links to said patent documents and said third section comprises file links to said patent files.”

For at least these reasons, claim 20 is believed to be allowable over Rivette, and claims 21, 23-29 and 31 are believed to be allowable at least by virtue of their dependence, either direct or indirect, from claim 20.

Claims 32-34

Claims 32 and 34 each recite, inter alia, “store, in said database, information including at least (i) correspondence generated from one or more of an inventor client system, an in-house client system and an outside representative client system; (ii) patent documents filed in or sent from a patent office; and (iii) patent files associated with said patent application, wherein at least some of said patent documents are stored in an image file format and at least some of said patent files are associated with an application program.” Claims 32 and 34 also each recite “generate a graphical user interface that can be displayed on said client system display to provide access to said information, said graphical user interface including at least first, second and third separate sections wherein said first section comprises a list of said correspondence, said second section comprises a list of said patent documents and said third section comprises a list of said

patent files.” These elements are similar to elements recited in claim 13, and for at least the reasons discussed with respect to claim 13, claims 32 and 34 are believed to be allowable as well. Claim 33 is believed to be allowable at least by virtue of its dependence from claim 32.

#### Claims 35, 36 and 38

Claim 35 recites first, second and third display sections similar to those recited in claim 13, and claim 35 is believed to be allowable at least because Rivette fails to teach or suggest those display sections, as described above with respect to claim 13. Moreover, claim 35 recites that “each of the document file links providing access to an application document that is associated with an application program and stored on a computer-readable medium, wherein at least one of the application documents is stored in a word processor format and corresponds to a file history document stored in an image file format that is accessible through the plurality of first file links.” This element is not even addressed by the office action, and it is believed that this element provides an additional point of novelty over Rivette. Hence, claim 35 is believed to be allowable for at least these reasons.

Claims 36 and 38 are believed to be allowable at least by virtue of their dependence from claim 35.

#### **§ 103 Rejections**

The office action rejected claims 12, 19, 22 and 30 under § 103(a) as being unpatentable over Rivette. Claim 12 depends from claim 1, claim 19 depends from claim 13, and claims 22 and 30 depend from claim 20. The claims rejected under § 103(a), therefore, are believed to be allowable by virtue of their dependence from allowable base claims.

#### **Conclusion**

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Application No. 09/919,764  
Amendment dated August 8, 2006  
Reply to Office Action of February 9, 2006

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: August 8, 2006

/Chad E. King/  
Chad E. King  
Reg. No. 44,187

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, CA 94111-3834  
Tel: 303-571-4000  
Fax: 415-576-0300  
CEK/jln  
60736507 v1